

As correctly noted in the Office Action Summary, Claims 1-21 are pending in the application and are under consideration.

By the above amendments, Claims 1, 2 and 20 have been revised in response to the objection. In addition, Claims 13-17 and 20 have been revised in response to the 35 U.S.C. §112, second paragraph, rejection which is further addressed below.

At the outset, the undersigned notes with appreciation the withdrawal of the election requirement.

Claims 1 to 21 stand objected to for minor informalities. This objection has been obviated by the above amendments, wherein Claims 1 and 21 have been revised to provide Markush form as suggested by the Examiner. Additionally, Claim 2 has been revised to correct a minor informality. Thus, withdrawal of this objection is respectfully requested.

Claims 3, 13-17 and 20 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at page 2 of the Official Action. This rejection has been obviated, at least in part, by the above amendments.

With respect to Claim 3, the Examiner has asserted that it is unclear what is intended by "a free valency." This recitation simply refers to the possibility where the

constituent addressed (e.g., W, Y), may optionally not be present. Thus, one of ordinary skill in the art would readily be apprized of the meaning of this phrase.

Claims 13-17 have been revised to eliminate the phrase "which can be". The dependency of Claim 15 has been revised to depend on Claim 6. Claims 16, 17 and 20 have been revised to provide a positive recitation of the process step referred to therein. For at least the above reasons, withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1, 3, 9, 11 and 20 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over *Jachmann et al* (U.S. Patent No. 5,187,251); Claims 13-17 stand rejected under §102(b) as being anticipated by *Jachmann et al*; and Claims 2, 9, 10, 12, 18, 19 and 21 stand rejected under §103(a) as being obvious over *Jachmann et al*. These rejections are traversed for the following reasons.

The present invention relates to a novel process for the preparation of functionalized silicone oils having at least one hydrocarbon-containing ring in which is included an oxygen atom. In particular, the subject-matter of the present

invention relates to a process for hydrosylation between polyorganohydrosiloxanes and unsaturated units including at least one hydrocarbon-containing ring having an oxygen atom. Some of the advantages associated with the claimed process include the formation of a polyorganosiloxane having a stable viscosity and being non-turbid.

Independent Claim 1 sets forth a process for the preparation of a nonturbid functionalized silicone oil of stable viscosity by hydrosilylation of a polyorganohydrosiloxane with synthons. The synthons hydrosilylated with the polyorganohydrosiloxane are different or identical, including at least one hydrocarbon-comprising ring in which is included at least one oxygen atom. The hydrosilylation reaction is carried out in the presence of a heterogeneous catalytic composition including a metal selected from the group consisting of cobalt, rhodium, ruthenium, platinum and nickel deposited on an inert support, said inert support selected from the group consisting of carbon black, charcoal, alumina, silicate and barium oxide. The polyorganohydrosiloxane is, linear or cyclic.

Jachmann et al relates to curable organopolysiloxanes having epoxy groups. In particular, *Jachmann et al* relates to

a method for synthesizing curable organopolysiloxanes having epoxy groups and to the use thereof as curable coating materials with adhesive properties as casting materials, and as coating materials for glass fibers. Column 1, lines 8-15.

Jachmann et al fails to disclose or suggest each feature of the claimed invention. For example, *Jachmann et al* does not disclose hydrosilylating the synthons with the polyorganohydrosiloxane containing only SiH groups, as in the present invention. In this regard, *Jachmann et al* states:

The introduction of the $-R_3OH$ group accordingly is accomplished by an addition reaction between appropriate alcohols with a terminal olefinic double bond and an organopolysiloxane having epoxy groups and, additionally, SiH groups.

Column 8, lines 56-60. Thus, the polyorganohydrosiloxane synthesized by *Jachmann et al* contains both SiH and epoxy groups, while the polyorganohydrosiloxane of the present invention contains only SiH groups.

Further, the Examiner has relied on Example 1 of *Jachmann et al* for the proposition that polyorganohydrosiloxane employed therein meets formula (XVI) of the claimed process. Official Action at page 3. This is not the case. The polydimethylsiloxane that is employed in the hydrosilylation of *Jachmann et al* includes R_3OH and epoxy groups. In

particular, the polydimethylsiloxane of *Jachmann et al* utilized in the hydrosilylation is first reacted with allyl alcohol ($=R_5OH$) and vinylcyclohexane in the presence of $H_2PtCl_6 \cdot 6H_2O$. Therefore, the allyl alcohol provides the R_3OH groups and the vinylcyclohexane provides the epoxy groups. Thus, clearly the polyorganohydrosiloxane utilized in the hydrosilylation of *Jachmann et al* is different from the one of the present invention. Moreover, the polyorganosiloxane of *Jachmann et al* does not exhibit the non-turbidity and stable viscosity of the functionalized silicone oil of the presently claimed invention.

Accordingly, for at least the foregoing reasons, withdrawal of these rejections is in order.


From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

Application No. 09/202,244
Attorney's Docket No. 022701-803

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

Respectfully submitted,

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Date: July 21, 2000